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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/669,620

09/24/2003

Daniel B. Roitman

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EXAMINER

JUNG, UNSU

ART UNIT

PAPER NUMBER

1641

NOTIFICATION DATE

DELIVERY MODE

04/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/669,620

Applicant(s)

ROITMAN ET AL.

Examiner

UNSU JUNG

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 February 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The proposed amendments to include additional limitation of "microbead particles is shaped differently from another of said microbead particles enabling said at least one particle to be visually distinguished from said another of said microbead particles for identification purposes," which would require further consideration and/or search. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Unsu Jung/
Primary Examiner, Art Unit 1641

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed on February 17, 2009 have been fully considered but they are not found persuasive essentially for the reasons of record and arguments addressed herein.

Applicant's argument that the transducing layer of Ravkin et al. is not individually discernable from the digital layer has been fully considered but is not found persuasive. As stated in the previous Office Action dated April 17, 2008 (see item 9), Ravkin et al. teaches a microbead particle system for bioassay with encoded patterns (see entire document, particularly column 10, lines 1-65). The encoded patterns can be provided by a carrier comprising a sandwich of individually discernable layers, which may differ in color, refractive index, reflectivity, shade, or texture (column 20, lines 49-56). Therefore, the prior art reference of Ravkin et al. contemplates use of sandwich of discernable layers differing in reflectivity. Therefore, the carrier layer of Ravkin et al. includes a layer having a defined reflectivity (a transducing layer) cooperating with a digital data layer (another layer having a different reflectivity) to product a detectable data signal.

Applicant's argument that the Examiner is attempting to read both the particle made of polymeric material and the transducing layer on the carrier material has been fully considered but is not found persuasive essentially for the reasons of record. Ravkin et al. teaches that various different coding means can be employed in combination (column 10, lines 7-9). Ravkin et al. teaches that microbead particles can be discernable by size, density, granularity, refractive index, color, fluorescence, or may contain yet another carrier or carriers that are further discernable (column 23, lines 30-33) and that the microbead particles can be made of polymeric material (column 23, lines 42-45). Therefore, Ravkin et al. contemplates that the polymeric microbead particles may further include additional carriers (such as sandwich of layers having different reflective layers as set forth above) that are further discernable and distinct from the polymeric carrier of the microbead particle.

Applicant's argument that Ravkin et al. does not disclose or suggest producing a detectable binary data signal has been fully acknowledged as the previous Office Action dated April 17, 2008 (see item 9) clearly states that Ravkin et al. fails to teach that the transducing layer produce a detectable binary data. Further, applicant's argument that Ravkin et al. teaches away from producing a detectable binary data signal because Ravkin et al. discloses that greater information content is achieved with fewer coding positions using spectrally coded carriers compared to the traditional binary bar code formats has been fully considered but is not found persuasive. Contrary to applicant's argument that Ravkin et al. teaches away from the claimed invention, it is noted that a prior art reference may be considered to teach away when "a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the appellant." See *In re Haruna*, 249 F.3d 1327, 58 USPQ2d 1517 (Fed. Cir. 2001). Further, in contrast to applicant's assertions disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See *In re Susi* USPQ 423 (CCPA 1971). A known or obvious composition does not patentable simply because it has been described as somewhat inferior to some other product for the same use. See *In re Gurley* 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). See MPEP 2123. Although, Ravkin et al. teaches that greater information content is achieved with fewer coding positions using spectrally coded carriers compared to the traditional binary bar code formats, there is no skepticism or discouragement in the prior art for employing binary data for uses that do not require the use of large encoding a large library of compounds.

Applicant's arguments directed to the proposed amended feature of the claim (microbead particles shaped differently from another of the microbead particles enabling one particle to be visually distinguished from another microbead particles for identification purposes) have not been considered as they require further consideration and/or search.

In view of the foregoing response to arguments, all of the prior art rejections set forth in the Final Office Action dated December 15, 2008 have been maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to UNSU JUNG whose telephone number is (571)272-8506. The examiner can normally be reached on M-F: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on 571-272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Unsu Jung/
Unsu Jung
Primary Examiner
Art Unit 1641